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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,091	01/14/2004	Mark Gregory Thompson	63637-00005USPT	3531
7590 JENKENS & GILCHRIST A Professional Corporation Suite 3200 1445 Ross Avenue Dallas, TX 75202-2799				
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EXAMINER				
BROWN, ALVIN L				
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3622				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/757,091

**Applicant(s)**

THOMPSON, MARK GREGORY

**Examiner**

ALVIN L. BROWN

**Art Unit**

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The following is a non-final, First Office Action on the merits. Claims 1- 20 are pending.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-10, 17, 19-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) tied to a particular machine or apparatus (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**5. Claims 1-16, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyd (20020194049) in view of Mayer (20050086211).**

**As per claims 1, 18,** Boyd discloses a method of profiling, matching and optimizing performance of large networks of individuals, comprising obtaining information of a user's preferences relative to a target, synthesizing the information into conclusions, estimating the fit between the user's preferences and a potential target's attributes, predicting an outcome of an encounter between a user and a target, observing the outcome between the user and the target.

Boyd does not explicitly disclose obtaining feedback from the user and the target after the occurrence of the encounter.

However, Mayer discloses obtaining feedback from the user and the target after the occurrence of the encounter (paragraph [0122]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Mayer's user feedback to Boyd's profiling and matching methods. One would be motivated to do this in order to allow members to provide feedback to the system for continuous improvements.

**As per claim 2,** Mayer further discloses obtaining input from one or more targets prior to the encounter between the user and said one or more targets (paragraph [0004]).

**As per claim 3,** Boyd further discloses classifying the user and target on the basis of the estimated fit quality between the user's preferences and the target's attributes (paragraph [0009]).

**As per claim 4**, Mayer further discloses the information of a user's preferences is obtained by one more modules involved in direct assessment, oblique assessment and input, wherein said input is obtained from peers or external judges (paragraph [0122]).

**As per claim 5**, Boyd discloses a method of matching large networks of individuals with one or more targets, comprising matching a user with a first set of potentially compatible targets based on mutually corresponding preferences, the first set being generated with a set of user-independent search criteria, modifying the user-independent search criteria with feedback from the user and criteria established by the user, and generating subsequent sets of potentially compatible targets based on the modified criteria (paragraphs [0009, 0011]).

**As per claim 6**, Boyd further discloses excluding a target from the sets of potentially compatible targets when the target has at least one characteristic inconsistent with a deal breaker criteria established by the user (paragraph [0057]).

**As per claim 7**, Boyd further discloses obtaining additional information from the user or a target when the information to ascertain a match between the user and the target is incomplete (paragraph [0059]).

**As per claim 8**, Boyd further discloses the user established feedback and criteria includes an assessment of the user's preference to specific target characteristics (paragraphs [0009, 0061]).

**As per claim 9**, Boyd further discloses linking the user to a matched target (paragraph [0009]).

**As per claim 10**, Boyd further discloses the step of matching the user with potentially compatible targets is further based on mutually corresponding persona preferences, the user's persona preferences measured along stated dimensions and along implicit dimensions (paragraphs [0009]).

**As per claim 11**, Boyd discloses system for profiling, matching and optimizing performance of large networks of individuals, comprising a server having a processor for executing a software application and for exchanging data related to the software application with a user over a network medium, wherein the software application contains logic to assess the preferences of the user along explicit and implicit dimensions and to match the user with potentially compatible targets based on the user's preferences (figure 1, paragraph [0062]).

**As per claim 12**, Boyd further discloses the software application contains logic to categorize the user with individuals having similar preferences for one or more targets (paragraph [0088]).

**As per claim 13**, Boyd further discloses the software application contains logic to reassess the user's preferences based on feedback received from the user (paragraph [0088]).

**As per claim 14**, Boyd further discloses the software application contains logic to estimate the fit between the user's preferences and a potential target's attributes (paragraph [0088]).

**As per claim 15**, Boyd further discloses the software application contains logic to predict an outcome of an encounter between a user and a target (paragraph [0088]).

**As per claim 16**, Boyd further discloses the software application contains logic to observing the outcome between the user and the target (paragraph [0088]).

**As per claim 19**, Mayer further discloses information of the user's preferences relative to a target is obtained by a combination of one or more processes including direct assessment, indirect assessment, feedback from a target group and tagging the user's preferences and attributes via a coding process (paragraph [0122]).

**As per claim 20**, Mayer further discloses estimation of the fit quality between the user and the object is based upon previously derived encounters between comparable users and objects or statistical modeling of scenarios that compare a single search result to the percentiles of all projected fit results (paragraph [0067]).

6. **Claims 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyd (20020194049) in view of Mayer (20050086211) further in view Rhoads (2080134232).**

As per claim 17, Boyd discloses a method for matching a user to a target, said method comprising the steps of:

performing tests that directly assess the user's preferences and attributes or the object's attributes via self-report clues and counter clues; performing tests that indirectly or obliquely assess the user's or the object's preferences and attributes via implicit methods; reporting the presented conclusions on the preferences and attributes of the user and the object in order to promote education and gain further feedback; customizing the presentation of information, education and advertising and facilitating commerce based on a user's or object's preferences and attributes; estimating the fit

quality between the user's preferences and attributes and the preferences and attributes of a pool of potential candidates and objects; providing the user control over the domain to be searched and the level of tolerance for false positives and false negatives; clustering heterogeneous groups of users and objects into homogeneous subgroups based on similarities in preferences and attributes; classifying the object on the basis of the user's satisfaction with the object; searching and ranking a pool of objects based on the estimated fit quality with the user's preferences and attributes; predicting an outcome following one or more encounters between the user and the object; optimizing the quality of the search and match process based on adjustment to the search and match parameters to narrow the gap between predicted and observed behavior; observing the user's behavior to assess the gap between predicted user and observed user actions and reactions obtaining feedback from the user and the object following at least one encounter between the user and the object; offering advice to the user that is tailored to the user's assessed goals and readiness for change; preparing the information between the user and the object prior to any encounter between the user and the candidate; preparing a user for an encounter with a target by sharing information on the target regarding areas of mutual compatibility while simultaneously priming expectations, trust and familiarity through the implicit use of custom images and words; synthesizing and presenting feedback received from potential targets to the user in a manner that fosters readiness for change; providing intervention to facilitate desired changes in the preferences and attributes of the user or the object; and testing the impact and effectiveness of words and images through an automated system that



randomly pulls and systematically evaluates the stimuli from a large pool of media (paragraphs [0009, 0084, 0104]).

Boyd does not explicitly disclose accessing a guide that serves as an agent for facilitating the search and match process and customizing related information;

allowing a user to personalize the guide's personality, image, representation, voice and other features;

obtaining feedback from a target group regarding the user's preferences and attributes or the object's attributes;

tagging the attributes of a user or an object via a semi-automated system involving human expert judgment.

However, Mayer discloses accessing a guide that serves as an agent for facilitating the search and match process and customizing related information;

allowing a user to personalize the guide's personality, image, representation, voice and other features; obtaining feedback from a target group regarding the user's preferences and attributes or the object's attributes; tagging the attributes of a user or an object via a semi-automated system involving human expert judgment (paragraphs [0004, 0045, 0122]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Mayer's user feedback to Boyd's profiling and matching methods. One would be motivated to do this in order to allow members to provide feedback to the system for continuous improvements.

Further, Rhoads discloses aggregating multiples clues and synthesizing the clues, while estimating the parameters and confidence levels in light of missing, inexact and contradictory information (paragraph [0164]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Rhoads' level of confidence in matching to Boyd's profiling and matching methods. One would be motivated to do this in order to provide higher levels of correspondence among members of the system.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALVIN L. BROWN whose telephone number is (571)270-5109. The examiner can normally be reached on Monday - Thursday 7:30 AM to 5:00 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571 272 6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALB

/Arthur Duran/  
Primary Examiner, Art Unit 3622